

**REMARKS**

Claims 63-109 are pending in the application. Claims 63 and 109 are allowed; claim 64 is rejected; and claims 65-108 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form. Applicants traverse the rejection of claim 64.

Claim 64 was previously amended to add a proviso. The proviso excludes from the claimed subject matter certain compounds allegedly found in the De Lombaert reference. The addition of that proviso results in applicant claiming less than the full scope of applicants' disclosure. Applicants' proviso is specifically directed to exclude the compounds of De Lombaert. Applicants acknowledged as much in their Amendment and Reply of April 15, 2003. Thus, applicants are merely excising the invention of another, to which they are not entitled, and are not creating an artificial subgenus or claiming new matter.

"Adequate description under the first paragraph of 35 U.S.C. §112 does not require *literal* support for the claimed invention." *Ex parte Parks*, 30 USPQ 2d 1234, 1236 (Bd. Pat. App. Int. 1994) (emphasis in original, citations omitted). It is enough if the disclosure conveys to one of ordinary skill in the art that appellant had possession of the concept of what is claimed. *Id.* (citation omitted). "Clearly, the observation of a lack of literal support does not, in and of itself, establish a *prima facie* case for lack of adequate descriptive support under the first paragraph of 35 U.S.C. 112." *Id.* (citations omitted).

The Court of Customs and Patent Appeals addressed a situation analogous to the present one in *In re Johnson*, 194 USPQ 187 (C.C.P.A. 1977). In *Johnson*, the Court cited its own precedent to the effect that:

Inventions are constantly made which turn out not to be patentable, and applicants frequently discover during the course of prosecution that only a part of what they invented and originally claimed is patentable.

194 USPQ at 195 (quoting *In re Wertheim*, 541 F.2d 257, 263, 191 USPQ 90, 97 (C.C.P.A. 1976)).

In *Johnson*, as here, applicants introduced a proviso to eliminate specific subject matter deemed to be not patentable to the applicants. There, the Court observed that "it is for the inventor to decide what *bounds* of protection he will seek." 194 USPQ at 196 (citing *In re Saunders*, 58 C.C.P.A. 1316, 1327, 444 F.2d 599, 607, 170 USPQ 213, 220 C.C.P.A. (1971)). Further, the Court continued to adopt the reasoning of *Saunders* noting that it would be improper to "let form triumph over substance, substantially eliminating the right of an applicant to retreat to an otherwise patentable species merely because he erroneously thought he was first with the genus when he filed." *Id.* Thus, the Court held that the "specification supported the claims in the absence of the limitation, and that specification, having described the whole necessarily described the part remaining. The facts of the prosecution are properly presented and relied upon, under these circumstances to indicate that appellants are merely excising the invention of another, to which they are not entitled, and are not creating an 'artificial subgenus' or claiming 'new matter.'" *Id.*

Here, a similar situation prevails. Applicants initially claimed a broader invention than that to which they are entitled. As in *Johnson*, applicants discovered during the course of prosecution that only part of what they had invented and originally claimed is patentable to them. Following the precepts of *Johnson* further, the inventors decided what bounds of protection they will seek. Furthermore, through the vehicle of the rejected proviso, applicants are merely excising the invention of another, to which they are not entitled, and are not creating an "artificial subgenus" or claiming "new matter." All that happened here is that appellants narrowed their claims to avoid having them read on the invention of another.

In view of the foregoing Remarks, it is respectfully submitted that the pending claims are in condition for allowance. Applicants respectfully request formal notification to that effect. If, however, the Examiner perceives any remaining impediments to such a notice of allowability, the Examiner is encouraged to contact Applicant's attorney at the number provided below. It is respectfully submitted that such informal communication will expedite examination and disposal of the instant case.

Respectfully submitted,

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